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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,669	10/23/2003	Matthew Lerner	003797.00675	5871

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EXAMINER
RUTLEDGE, AMELIA L

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 07/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/690,669	LERNER ET AL.	
	Examiner	Art Unit	
	Amelia Rutledge	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 April 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-44* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-44* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *4/6/06;4/6/06;4/21*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: Amendment, filed 04/21/2006.

2. Claims 1-44 are pending in the case. Claims 1, 13, 27, 41, and 43 are independent claims.

3. The amendment to the specification filed 04/21/2006 corrects minor typographical errors and is accepted.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 41-44 are rejected under 35 U.S.C. 102(b) as being anticipated by Montlick, U.S. Patent No. 5,561,446, issued October 1996.**

Regarding independent claim 41, which cites: *A method, comprising: sending data from an application program to an operating system, wherein the data requests activation of an electronic ink entry region when storing information associated with a document or file on the application program; receiving the data in the operating system; and sending a user interface including the electronic ink entry region to the application program when the application program seeks to store information associated with a document or file.*

Montlick teaches a method for wireless remote information retrieval and pen based data

entry for relating handwriting to other information without attempting to convert the handwriting to typed text (Col. 2, l. 37-41). Montlick teaches a method of associating electronic ink data with form fields of a form document in a computer system (Col. 8, l. 65-Col. 9, l. 25), and a method of storing and accessing the ink data (Col. 10, l. 6-37). Montlick teaches sending data from the application program to an operating system, where the data requests activation of an ink entry region when storing information, i.e., the graphical user interface receives events generated by the stylus and performs appropriate actions (Col. 5, l. 49-Col. 6, l. 20). Montlick teaches that the user interface may be updated on a periodic basis by the central computer system and that the interface may also allow manual saves of data entry regions, i.e., electronic ink entry regions (Col. 7, l. 45-10). Further the notes can be saved, edited, and recalled by specific entry region (Col. 8, l. 10-64).

Regarding dependent claim 42, Montlick teaches that data is sent as part of a call requesting return of the user interface and activation of a process for storing data associated with the form document, as in the automatic transmission of electronic ink data from the application interface program to the central computer system on an automatic periodic basis for updates (Col. 7, l. 45-Col. 8, l. 9). It is inherent in the disclosure of Montlick that this transmission would be sent as part of a call, since the application is written in C++ (Col. 6, l. 59-Col. 7, l. 3).

Regarding independent claim 43 and dependent claim 44, claims 43 and 44 reflect the computer readable medium including computer executable instructions used

for implementing the methods as claimed in claims 41 and 42, and are rejected along the same rationale.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. **Claims 1-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montlick in view of Wilcox et al. (hereinafter "Wilcox"), "Dynomite: A Dynamically Organized Ink and Audio Notebook", CHI 97, March 1997, p. 186-193.**

Independent claim 1 cites: *A computer system, comprising: an input system that receives electronic ink data that is metadata associated with a document or file on or accessible by the computer system; a storage system that stores the electronic ink data associated with the document or file; and an ink access system that allows the operating system to access at least some of the stored electronic ink data.*

Montlick teaches a method for wireless remote information retrieval and pen based data entry for relating handwriting to other information without attempting to convert the handwriting to typed text (Col. 2, l. 37-41). Montlick teaches a method of associating electronic ink data with form fields of a form document in a computer system (Col. 8, l. 65-Col. 9, l. 25), and a method of storing and accessing the ink data (Col. 10, l. 6-37). While Montlick does not explicitly teach that the electronic ink data is metadata

associated with a document or file, Wilcox teaches receiving electronic ink data that is metadata associated with a document or file on or accessible by the computer system. Wilcox teaches assigning electronic ink metadata in the form of properties and keywords to documents and note files (p. 100, col. 1, par. 2-4). Wilcox and Montlick are analogous art, because both are directed toward the rendering, linking, and storage of electronic ink data. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Wilcox to Montlick, because Montlick relates handwriting to other information without attempting to convert the handwriting to typed text (Montlick, Col. 2, l. 37-41), and Wilcox provides electronic ink indexes and views of notebook content based on time, properties and keywords, thereby giving the user the benefit of easily finding and organizing information in their notebook (Wilcox, p. 190, par. 2).

Regarding dependent claims 2-7, Montlick teaches a system in which electronic ink data can be given digital meaning without recognizing the handwriting as text, and giving electronic ink the context of specific fields to associate the data with specific fields (Col. 11, l. 19-34), and rendering form fields in electronic ink based on stored data (Col. 10, l. 6-37), compare to claim 3, *a rendering system for rendering the title in electronic ink based on the stored electronic ink data.*

Montlick does not explicitly teach that the electronic ink data includes an electronic ink title for the document (claim 2), or rendering the title as part of file operations on the display (claims 4-7). However, Wilcox teaches a pen based notebook computer with electronic ink indexes. Wilcox teaches rendering an image of a

document title as part of a file list operation, where different articles can be selected by an electronic ink hyperlink (p. 190, Col. 2, par. 3-4). Wilcox teaches a page preview rendering with a grouping of notes with an associated property (p. 191, Fig. 5). Wilcox also teaches the use of a title bar and/or application bar corresponding to electronic ink notes which represent links to electronic ink documents (Fig. 5).

Wilcox and Montlick are analogous art, because both are directed toward the rendering, linking, and storage of electronic ink data. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Wilcox to Montlick, because Montlick relates handwriting to other information without attempting to convert the handwriting to typed text (Montlick, Col. 2, l. 37-41), and Wilcox provides electronic ink indexes and views of notebook content based on time, properties and keywords, thereby giving the user the benefit of easily finding and organizing information in their notebook (Wilcox, p. 190, par. 2).

Regarding dependent claim 8, Montlick teaches that the input system is activated in response to data indicating that ink input should be activated for an electronic form (Col. 8, l. 10-64), compare to *wherein the input system is activated in response to data from an application program indicating that electronic ink input should be activated with respect to at least one document or file in the application program.*

Regarding dependent claim 9, Montlick teaches that the handwriting data is saved to the input system as electronic ink (Col. 9, l. 50-58).

Regarding dependent claims 10 and 11, Montlick teaches a method of associating electronic ink data with form fields of a form document in a computer system

(Col. 8, l. 65-Col. 9, l. 25) when the fields are changed by a user, therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to save the electronic ink data when an electronic ink title is added to an existing document or file, since a title is a type of field and Montlick teaches associating electronic ink data with fields.

Regarding dependent claim 12, Montlick teaches that the electronic data includes an electronic ink title (Col. 8, l. 40-44).

Regarding independent claim 13, claim 13 reflects the method implemented by the system as claimed in claim 1, and is rejected along the same rationale.

Regarding dependent claims 14-19, claims 14-19 reflect the methods implemented by the system as claimed in claims 2-7, respectively, and are rejected along the same rationale.

Regarding dependent claim 20, Montlick teaches a method of storing and accessing the ink data (Col. 10, l. 6-37) where information associated with the form is rendered as electronic ink.

Regarding dependent claims 21 and 22, claims 21 and 22 reflect the methods implemented by the system as claimed in claims 8 and 9, respectively, and are rejected along the same rationale.

Regarding dependent claims 23, 24, 37, and 38, claims 23, 24, 37, and 38 are directed toward substantially similar subject matter as claimed in claims 10 and 11, respectively, and are rejected along the same rationale.

Regarding dependent claim 25, Montlick teaches a method of associating electronic ink data with form fields of a form document in a computer system (Col. 8, l. 65-Col. 9, l. 25) when the fields are changed by a user, and Montlick teaches that the association of electronic data includes an electronic ink title (Col. 8, l. 40-44).

Regarding independent claim 27, claim 27 reflects the computer-readable medium including computer-executable instructions used by the system as claimed in claims 1, 8, and 9, and is rejected along the same rationale.

Regarding dependent claims 28-33, claims 28-33 reflect computer-readable medium including computer-executable instructions used by the system as claimed in claims 2-7, respectively, and are rejected along the same rationale.

Regarding dependent claims 34, 35, and 36, claims 34, 35, and 36 reflect the computer-readable medium including computer-executable instructions used to implement the methods claimed in claims 20, 21, and 22, respectively, and are rejected along the same rationale.

Regarding dependent claim 39, claim 39 is directed toward substantially similar subject matter as claimed in claim 25, and is rejected along the same rationale.

Response to Arguments

8. Applicant's arguments filed 04/21/2006 have been fully considered but they are not persuasive. Applicant has amended independent claims 1, 13, and 27 to add the limitation ...*electronic ink data that is metadata associated with a document or file on or accessible by the computer system.* As discussed in the rejections above, while

Montlick does not explicitly teach that the electronic ink data is metadata associated with a document or file, Wilcox teaches receiving electronic ink data that is metadata associated with a document or file on or accessible by the computer system. Wilcox teaches assigning electronic ink metadata in the form of properties and keywords to documents and note files (p. 100, col. 1, par. 2-4).

9. Applicant argues in regard to independent claim 41 that Montlick does not disclose the claimed combination of features (Remarks, p. 10, par. 4), *sending data from an application program to an operating system, wherein the data requests activation of an electronic ink entry region when storing information associated with a document or file on the application program; receiving the data in the operating system; and sending a user interface including the electronic ink entry region to the application program when the application program seeks to store information associated with a document or file*, however, Montlick does teach the combination of features as claimed, since Montlick teaches a central computer system with a DOS based Intel processor (Col. 4, l. 57), DOS is an acronym signifying Disk Operating System. Further, as discussed in the rejection of claim 41, above, Montlick teaches sending data from the application program to the operating system of the central computer system, where the data requests activation of an ink entry region when storing information, i.e., the graphical user interface receives events generated by the stylus and performs appropriate actions (Col. 5, l. 49-Col. 6, l. 20). Montlick teaches that the user interface may be updated on a periodic basis by the central computer system and that the interface may also allow manual saves of data entry regions, i.e., electronic ink entry

regions (Col. 7, l. 45-10). The notes can be saved, edited, and recalled by specific entry region (Col. 8, l. 10-64). Montlick does teach sending the user interface from the central computer system to the application program, since Montlick teaches that forms are stored on the central computer system and sent to the application program, and forms were a user interface including electronic ink entry region.

For similar reasons, the rejections of independent claim 43 are maintained.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amelia Rutledge whose telephone number is 571-272-7508. The examiner can normally be reached on Monday - Friday 9:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AR

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